

REMARKS

Claims 1-30 and 34-51 remain in this application. Reconsideration and review of the application is respectfully requested in view of the following remarks.

In the present response, the Applicant submits factual evidence to show that the present invention would not have been obvious over the prior art. The enclosed Declaration of Gerard A. Wall establishes that it was generally believed in the prior art that the clipping of video data in a computer network had to be done on the client unit (and the server did not clip or know what is currently being displayed on the client unit). To put it another way, it was generally believed that what is actually being displayed on the client unit had to be determined at the client unit. See Declaration of Gerard A. Wall ¶¶ 4-6 and 8. Nevertheless, the present invention pushes in the opposite direction (i.e., against industry philosophy and trends) by clipping video data at the server (e.g., decision making for data clipping is performed at the server and not at the client). See Declaration ¶ 7.

Moreover, Mr. Wall tested a prototype display system constructed according to the invention, and confirmed its surprising result; that is, video images can be clipped at the server and transmitted to a client for display without compressing the image. See Declaration ¶ 9. In this case, there is clearly a difference between data compression and data clipping. In addition, there is an especially strong nexus between this rebuttal evidence to the rejection and the present invention. That is, this objective evidence of non-obviousness directly pertains to the invention, and the Declaration of Mr. Wall is powerful evidence of non-obviousness. See M.P.E.P. 2144.08 (II)B ("Office personnel should consider declarations from those skilled in the art praising the invention . . . [r]ebuttal evidence may include evidence of the state of the art, the level of skill of the art, and the beliefs of those skilled in the art."); M.P.E.P. 2144.08 (III) ("A determination under 35 U.S.C. should rest on all the evidence and should not be influenced by any earlier conclusion.")

In the present Office Action, the Examiner again rejected Claims 1-30 and 34-51 under 35 U.S.C. §103(a) as being unpatentable over Nguyen in view of Munson. These rejections are respectfully traversed.

The Examiner has not properly made out a *prima facie* case of obviousness to independent Claims 1, 11, 21, and 34. Specifically, on page 3 of the Office Action, the Examiner acknowledges that "Nguyen *fails* to specifically disclose clipping image." To make up for this deficiency, the Examiner indicates that Nguyen "generally discloses playing video clip in figure 4 (col. 4, lines 27-52) by compress and decompress video images." The Office Action then indicates that, "Munson specifically teaches clipping image by clipping a video image." The Office Action then asserts that Munson can be combined with Nguyen because "[i]n video processing, compression and decompression of video images involved clipping video images to restore them into another system."

One of the main defects of the above assertion for combining Nguyen with Munson is that the compression of video data is not equivalent to clipping of video data. That is, video data that is "compressed" must be later "decompressed" before it can be displayed properly. By contrast, one of the main objectives of clipping video data is to not display the data that has been clipped or occluded. Accordingly, "compression and decompression of video images [do not] involved clipping video images to restore them into another system." To put it another way, the disclosure of compression and decompression of video images in Nguyen can not suggest or teach video clipping (or be combined with a clipping system, such as Munson) because video clipping is not a specie or within a category of video compression and decompression.

In addition, the Applicant would like to point out that the disclosure in Nguyen of the phrase "video clip" should not be confused with the present invention's clipping of video data. That is, a video clip is describing a segment of a video that is separated from another segment in time rather than clipping of a region of the data in space.

Moreover, Nguyen is only directed to the delivering of video data (a video clip)

and not clipping of video data, over an analog network separated from a digital data network to an end station for display. The only purpose in Nguyen for delivering a video clip or video data over the analog network to the end station is that the analog network has a lower cost and a higher bandwidth. However, in order to utilize the analog network, Nguyen specifically discloses that its video data has to be decompressed (and D/A converted) before it can be passed on to the analog network and reach its end station for display. Thus, Nguyen does not even pass its compressed video data to an end station for display and, therefore, certainly also cannot suggest passing clipped video data to an end station for display.

By contrast, the present invention is directed to the use of a digital network for the delivery (and transport) of clipped video data from the server to the actual terminal device for display in order to simplify the terminal device (i.e., the thin client). Thus, because Nguyen addresses a completely different problem of broadcasting the video data over a low cost, high bandwidth analog network (at the expense of having to decompress the digital video data and turn the decompressed digital video data into analog data before transmitting it to its end station), there is no suggestion, teaching, or motivation to combine Nguyen with any other reference (e.g., Munson) to teach clipping of video data at the sever via a digital network to reduce the actual amount of digital data sent to an individual thin client for display prior to this invention. Such a rejection represents an impermissible use of hindsight in an attempt to reconstruct missing features in the prior art.

The Munson reference is only cited for its disclosure of clipping of video data. Munson's disclosure is limited to clipping within a single computer and, more specifically, within the graphic card of the computer. It should be first noted that there is no teaching or suggestion to combine the implementations of digital data transfer within a single computer in Munson with the transmission of video data from a server (to a C-box over a digital network) to an end station over an analog network in Nguyen. In addition as mentioned above, there is no motivation to combine the compression and

decompression of video data in Nguyen with the unrelated clipping of video data within a single computer in Munson. Thus, in combining these two references, the Examiner has merely selected unrelated prior art references in an attempt to reconstruct Applicant's invention. It is impermissible to use the inventor's disclosure as a "road map" for selecting and combining prior art disclosures. In *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985), the Federal Circuit noted that "[t]he invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time." Likewise, in *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992), the Federal Circuit admonished against hindsight reconstruction of an invention in the manner reflected by the present rejections. According to the Federal Circuit:

[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. ... This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'

See also *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991) ("As in all determinations under 35 U.S.C. § 103, the decisionmaker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the Applicant's structure as a template and selecting elements from references to fill the gaps.")

Regardless, Munson (either alone or in combination with Nguyen) fails to make up for the deficiencies of Nguyen discussed above.

Furthermore, the two references (including Col. 5, lines 17-43 and Figure 1 of Nguyen cited by the Examiner as teaching this limitation) do not actually disclose or suggest a "receiver scaling of said regionally clipped imaged for display." See independent Claim 1, 11, 21, and 34; see also dependent Claims 9, 10, 19, and 20 and page 2 of the Office Action. Accordingly, the rejection of independent Claims 1, 11, 21,

and 34 and dependent Claims 9, 10, 19, and 20 should be withdrawn for this additional reason. See M.P.E.P. 2143.03 ("To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.)

For the foregoing reasons, the Examiner has not properly made out a *prima facie* case of obviousness. But even if such a case has been made, it would be effectively rebutted by the objective evidence of non-obviousness that has been made of record. That is, in view of the general industry philosophy and trends of clipping only at the display unit, it would not have been obvious to build a display system with clipping at the server as defined by the present claims. See Declaration of Gerald A. Wall and independent Claims 1, 11, 21, and 34.

In view of the foregoing, the Applicant respectfully submits that Claims 1-30 and 34-51 are in condition for allowance. Reconsideration and withdrawal of the rejections is respectfully requested, and a timely Notice of Allowability is solicited. To the extent it would be helpful to placing this application in condition for allowance, the Applicant encourages the Examiner to contact the undersigned counsel and conduct a telephonic interview.

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To the extent necessary, Applicant petitions the Commissioner for an one-month extension of time, extending to February 9, 2004, the period for response to the Office Action dated October 8, 2003. The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,



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Enclosure: Declaration of Gerard A. Wall (4 sheets)